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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,033	06/25/2001	Howard H. Liebermann	30-4698US/11872-026001	9448

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06/18/2002

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT

PAPER NUMBER

1742

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,033

Applicant(s)

ORLOFF ET AL.

Examiner

George P Wyszomierski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a product, classified in class 148, subclass 304.
- II. Claims 14-19, drawn to a process, classified in class 148, subclass 561.

2. The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process, such as by using a quench wheel of a defined surface configuration.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Roger Criss on May 1, 2002 a provisional election was made with oral traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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6. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The definition of the term "articulated topographical definition" as it applies to the instant claims is uncertain. For purposes of examination, the examiner will give this term its broadest reasonable structural interpretation, i.e. will interpret it as referring to a surface which is non-planar or not completely flat.

b) The term "may be" in line 2 of claims 4 and 5 renders these claims indefinite, as it is unclear whether or not the limitations which "may be" present are required in the claimed articles.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Narasimhan (U.S. Patent 4,332,848).

Narasimhan discloses glassy metal strips having a composition within the limitations of instant claim 4 and which contain a repeating geometrical pattern of structurally defined protuberances and/or indentations. With respect to claims 6-9, the examiner's position is that the suitability of a material for abrasive or cutting purposes is directly related to its composition, shape, and relative hardness to the material being abraded or cut. Because all of these parameters are the same in the prior art or the claimed invention, the examiner's position is that

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the claimed limitations are inherent in the Narasimhan material. Thus, the Narasimhan products are held to fully meet the limitations of the instant claims.

9. Claims 1, 2, and 4-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al. (U.S. Patent 5,622,768).

Watanabe discloses wound or laminated magnetic cores made from amorphous alloy strips having a composition within the limitations of instant claims 4 and 5. The limitations of instant claims 6-9 are inherent in the Watanabe materials for reasons as set forth in item no. 8 supra. The Watanabe materials have a defined surface roughness value (see Watanabe Table 2) and are thus held by the examiner to possess "articulated topographical definition". Thus, the Watanabe products are held to fully meet the limitations of the instant claims.

10. Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al. (U.S. Patent 4,865,664).

Sato discloses amorphous alloy strips having a composition within the limitations of instant claims 4 and 5. The limitations of instant claims 6-9 are inherent in the Sato materials for reasons as set forth in item no. 8 supra. The Sato materials have a defined surface roughness value (see the Tables of Sato) and are thus held by the examiner to possess "articulated topographical definition". Thus, the Sato products are held to fully meet the limitations of the instant claims.

11. Claims 1, 2, and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 62-250153.

The JP '153 reference discloses laminated amorphous metal sheets with a defined surface roughness; this is taken to be the full patentable equivalent of the claimed "articulated topographical definition". The limitations of instant claims 6-9 are held to be inherent in the JP

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'153 materials for reasons as set forth in item no. 8 supra. Thus, the products disclosed in JP '153 are held to fully meet the limitations of the instant claims.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan in view of Watanabe et al. or Sato et al.

The Narasimhan products do not appear to contain element "Z" as defined in instant claim 5. However,

a) It is unclear whether or not this element is required in the claimed products, for reasons as stated in the rejection under 35 USC 112 (see item no. 6(b) supra).

b) The Watanabe and Sato et al. patents indicate that it is conventional in the art to include element "Z" in amorphous alloy strip compositions, in the amounts as defined in the instant claim.

Consequently, the Watanabe or Sato disclosures would have motivated one of ordinary skill in the art to produce the Narasimhan products containing an amount of element "Z".

14. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan in view of either Watanabe et al. or Bruckner (U.S. Patent 4,853,292).

The Narasimhan patent does not discuss a plurality of stacked materials or transformer cores, as required by the instant claims. Both Watanabe and Bruckner indicate it to be conventional in the art to form laminated magnetic cores by using a plurality of layers of

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amorphous metal alloys. These disclosures would have motivated one of ordinary skill in the art to form the materials disclosed by Narasimhan into the configurations as set forth by Watanabe or Bruckner.

15. Applicant is advised that should claim 2 be found allowable, claim 10 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. All limitations of claim 10 appear to be fully contained in claim 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

16. The remainder of the art cited on the enclosed PTO-892 and 1449 forms is of interest. This art is held to be no more relevant to the claimed invention than the art as applied in the rejections, supra.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for this Group is (703) 872-9310. The Right fax number for this examiner is (703) 872-9039. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW
June 14, 2002